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EXAMINER
KINDRED, ALFORD W

ART UNIT	PAPER NUMBER
2163	

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	08/768,606	BUSEY ET AL.
	Examiner	Art Unit
	Alford W. Kindred	2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 November 2005</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>10-48, 66-67 and 69-97</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>10-48, 66-67 and 69-97</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)   Office Action Summary   Part of Paper No./Mail Date 20060127

DETAILED ACTION

1.   This action is responsive to communications: Amendment, filed on 11/18/05.

This action is made final.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created

doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*,

418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
used to overcome an actual or provisional rejection based on a nonstatutory double
patenting ground provided the conflicting application or patent is shown to be commonly
owned with this application. See 37 CFR 1.130(b).
Effective January 1, 1994, a registered attorney or agent of record may sign a
terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
37 CFR 3.73(b).

Claims 10 and 28 are rejected under the judicially created doctrine of double

patenting over claims 1 and 17 of U. S. Patent No. US# 6,785,708 B1 since the claims,

if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the

patent and is covered by the patent since the patent and the application are claiming

common subject matter, as follows: claims 10 and 28 of the instant application recite

establishing a chat region controlled by a browse while Claims 1 and 17 of Patent recite

"establishing browser and chat region on a first display". The establishing of chat

regions in browsers and displays includes the ability to process chat functions and thus,

the applications claims of 10 and 28 are obvious over the Patent's claims 1 and 17

Furthermore, there is no apparent reason why applicant was prevented from

presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158

USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 U.S.C. § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
>
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
>
> the prior art are such that the subject matter as a whole would have been obvious at the time the
>
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
>
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 10-48, 66-67, and 69-97 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Volano, "VolanoChat Java solution turns ordinary web sites into

interactive money makers", Business Wire, pp.1-2, in view of Judson, U.S. Patent

Number 5,572,619, filed 10/19/95, class 395/793, title "Web browser with dynamic

display of information objects during linking", and further view of Donath et al., 1996.

   With respect to independent claim 10, **Volano** discloses,   "establishing a chat

region controlled by a chat client" ("VolanoChat works with all Java-compatible browsers

. . . can accommodate large numbers of simultaneous real-time interactions . . . such as

browser plug-ins, Internet chat . . ."--page 1 of 2). **Volano** does not disclose "a browser

frame controlled by a browser client . . .". **Anupam** discloses "a browser frame

controlled by a browser client . . . with the browser region" (see fig. 1,--sheet 1 of 4. It

would have been obvious at the time of the invention for one of ordinary skill in the art to

have combined the teachings of Anupam and Volano above, because using the steps of

a browser client that is controlled by a browser frame, would have given those skilled in

the art the ability to incorporate chat functions in a user's browser. **Volano** does not

disclose "in response to a command received by a computer, establishing a browser . .

.". **Judson** discloses "in response to a command received by a computer, establishing

a browser . . ." ("client machine having a browser, wherein the information objects are

downloading of a hypertext object, selectively displaying one of the stored information

objects . . ."--column 10, line 53). It would have been obvious at the time of the

invention for one of ordinary skill in the art to have combined the teachings of Judson "in

response to a command received by a computer, establishing a browser . . ." ("client

machine having a browser, wherein the information objects are downloading of a

hypertext object, selectively displaying one of the stored information objects . . ."--

column 10, line 53) with the teachings of Volano above, because using the steps of "in

response to a command received by a computer, establishing a browser . . ." would

have given those skilled in the art the tools to create a browser in the an Internet

environment. This give users the ability to user browsers to view and manipulate

information on the Internet via commands of a computer. **Volano** does not explicitly

teach "the chat region being a real time . . . chat region synchronized with the browser

region; in response to receiving chat content including a link to a web page . . .

detecting selection, by a user of the display device . . . invoking the browser client . . .

the link and displaying the obtained web page in the browser region" (see pages 1-4).

Donath et al. teaches " the chat region being a real time . . . chat region synchronized

with the browser region; in response to receiving chat content including a link to a web

page . . . detecting selection, by a user of the display device . . . invoking the browser

client . . . the link and displaying the obtained web page in the browser region" (see

pages 1-4). It would have been obvious at the time of the invention for one of ordinary

skill in the art to have combined the teachings of Volano and Donath because using the

steps of " the chat region being a real time . . . chat region synchronized with the

browser region; in response to receiving chat content including a link to a web page . . .

detecting selection, by a user of the display device . . . invoking the browser client . . .

the link and displaying the obtained web page in the browser region", would have given

those skilled in the art the tools to link web page data while also detecting and

manipulating chat content in a fashion illustrated in applicant's claim language above.

This give users the advantage of improving the transmission of chat content more

efficiently.

With respect to dependent claim 11, **Volano** discloses "displaying the chat region

and the browser region simultaneously on the display device; and allowing a user to

concurrently perform a chat function, a browser function or both" ("simultaneous real-

time interactions . . . user-group support . . ."--page 1 of 2).

With respect to dependent claim 12, **Volano** discloses "establishing the browser

and chat regions on the display device, the command being received by the computer

from a user or a computer network" ("optimized for novice Web users that just want to

chat . . . all the Java chat applications . . ."--page 1 of 2).

With respect to dependent claim 13, **Volano** discloses "with a chat client resident

on the computer, processing chat content using a browser server for display in the chat

region; with a browser resident on the computer, processing a document or other

content for concurrent display in the browser region" ("Volano markets Java solutions

for multi-user environments . . . a Web-based chat solution written entirely in Java . .

."page 2 of 2).

With respect to dependent claim 14, **Volano** discloses "linking the chat client to

the browser so that the chat client controls the content displayed in the browser region."

Judson discloses "linking the chat client to the browser so that the chat client controls

the content displayed in the browser region" ("the first hypertext document . . . link that

initiates downloading of the second hypertext document . . ."--column 8, line 45). It

would have been obvious at the time of the invention for one of ordinary skill in the art to

have combined the teachings of Judson "linking the chat client to the browser so that

the chat client controls the content displayed in the browser region" ("the first hypertext

document . . . link that initiates downloading of the second hypertext document . . ."--column 8, line 45) with the teachings of Volano above, because using the steps of "linking the chat client to the browser so that the chat client controls the content displayed in the browser region" would have given those skilled in the art the tools to link chat data controls to the client. This gives users at the client the benefit of using browser functions when operating in the chat mode.

with respect to dependent claim 15, **Volano** discloses "linking the chat client to the browser through an application program interface of the browser" ("administrative features include modification of all user-interface text . . ."--page 1 of 2).

With respect to dependent claim 16, **Volano** discloses "in response to the chat content received by the computer, invoking the chat client through the application program interface, so that the chat content is displayed in the chat region" ("VolanoChat supports banner advertisements in its chat rooms . . ."--page 1 of 2).

With respect to dependent claim 17, **Volano** discloses "so that the chat content is displayed in the chat region, the chat content being of a particular MIME type" ("the first Java based chat solution . . . complete administrative control . . ."--page 1)

With respect to dependent claim 18, **Volano** does not disclose "so that the chat content is displayed in the chat region, the chat client including a file having a particular extension." **Judson** discloses "so that the chat content is displayed in the chat region, the chat client including a file having a particular extension" ("supports files in the form of documents and pages . . . protocol that provides user access to files . . ."--column 3, line 53). It would have been obvious at the time of the invention for one of ordinary skill

in the art to have combined the teachings of Judson "so that the chat content is

displayed in the chat region, the chat client including a file having a particular extension"

("supports files in the form of documents and pages . . . protocol that provides user

access to files . . ."--column 3, line 53) with the teachings of Volano above, because

using the steps of "so that the chat content is displayed in the chat region, the chat

client including a file having a particular extension" would have given those skilled in the

art the tools to recognize and display data according the extension without opening the

entire file.

With respect to dependent claim 19, **Volano** discloses "linking the chat client to

the browser through the application program interface, the application program interface

being implemented as a plug-in architecture" ("chat technologies, such as browser plug-

ins . . ."--page 1 of 2).

With respect to dependent claim 20, **Volano** discloses "an ActiveX architecture"

("Volcano server runs on any platform that supports Java, including Microsoft . . ."--page

1 of 2).

With respect to dependent claim 21, **Volano** discloses "displaying the chat

content in the chat region" ("Java based chat solution to offer in-room advertising . . ."--

page 1 of 2).

With respect to dependent claim 22, **Volano** discloses "displaying the browser

content in the browser region" ("Browser plug-ins, Internet Relay chat . . ."--page 1 of 2).

With respect to dependent claim 23 and 66-68, **Volano** does not disclose "the

browser content including a markup language document." **Judson** discloses "the

browser content including a markup language document" ("HTML tag is a "comment," . .

. by the browser . . . HTML elements . . ."--column 5, line 6). It would have been

obvious at the time of the invention for one of ordinary skill to have combined the

teachings of Judson "the browser content including a markup language document"

("HTML tag is a "comment," . . . by the browser . . . HTML elements . . ."--column 5, line

6) with the teachings of Volano above, because using the step of "the browser content

including a markup language document" would have given those skilled in the art the

tools to view markup language via a browser. This gives users the ability to view

interactions with information on the Internet.

With respect to claim 24, this claim is rejected on grounds corresponding to the

arguments given above for rejected claim 3 and is similarly rejected.

With respect to dependent claim 25, **Volano** does not disclose "establishing the

chat region embedded in the web page; and establishing the Web page embedded in

the browser region." **Judson** discloses "establishing the chat region embedded in the

web page; and establishing the Web page embedded in the browser region" (the

browser may be suitably programmed to queue the mini web page . . ."--column 6, line

42). It would have been obvious at the time of the invention for one of ordinary skill in

the art to have combined the teachings of Judson "establishing the chat region

embedded in the web page; and establishing the Web page embedded in the browser

region" (the browser may be suitably programmed to queue the mini web page . . ."--

column 6, line 42) with the teachings of Volano above, because using the steps of

"establishing the chat region embedded in the web page; and establishing the Web page embedded in the browser region" would have given those skilled in the art the ability to send and retrieve chat functions from embedded web pages and browsers. This allows users to communicate faster in chat rooms and the like.

With respect to claims 26 and 27, these claims are rejected on grounds corresponding to the arguments given above for rejected claim 3 and are similarly rejected.

With respect to independent claim 28 and dependent claims 29-47, these claims are rejected on grounds corresponding to the arguments given above for rejected independent claim 10 and dependent claims 11-27. In independent claim 28 and dependent claims 29-47, Applicant claims a system which contains means corresponding to the steps of the method of independent claim 10 and dependent claims 11-27.

As per claim 67, this claims is rejected on grounds corresponding to the arguments given above for rejected claim 10 and is similarly rejected.

As per claims 69-70, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10 and 28, above and are similarly rejected.

As per claims 71-83, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10-27 and are similarly rejected.

As per claims 84-97, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10-22 and 28-32 and are similarly rejected including the following:

--Volano teaches "{a first chat session . . . a first target . . . second target . . ."
(see pages 1-2).

Response to Arguments

5.   Applicant's arguments filed 11/18/05 have been fully considered but they are not
persuasive.

--As per applicant's arguments regarding "Volano fails to describe synchronizing
chat and browser regions after a link has been selected within a chat region on the
web", examiner maintains that Volano's teachings of chat and server software and
Donath's teachings of the synchronization of chat regions in a browser, reads on
applicant's claim language above.

--As per applicant's arguments regarding "Anupam neither discusses users
selecting links nor a browser to synchronize link selection within a chat session and
browsing functions, because all browsing is controlled by the originator", examiner
refers applicant to Anupam's teachings of a browsing element in a collaborative forum
of computer participants working together, combined with Donath's teachings of the
synchronization of chat regions in a browser, reads on applicant's amended claim
language above.

--As per applicant's arguments regarding "Donath, a user can anchor to a web
page . . . however, merely describing following a link fails to describe a browser with
synchronized chat and browsing functions", examiner disagrees with the above
assertions and maintains that Donath's chat regions on page 2-3 clearly demonstrate

the synchronization of chat and browsing functions as illustrated in application claim

language.

--In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, references

Volano, Anupam, Judson and Donath, are related in the fact that each reference teach

the element of browsers being used in connection with some type of chat

communications over a networking system which similar to applicant's claim language

and thus, the use of the combination of references above is proper.

Conclusion

6.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time
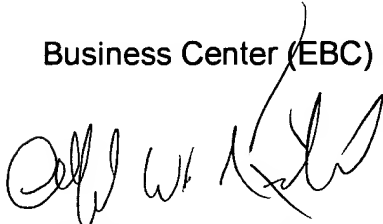
policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Alford W. Kindred whose telephone number is 571-272-

4037. The examiner can normally be reached on Mon-Fri 9:00 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Alford W. Kindred
Patent Examiner
Tech Ctr. 2100